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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,117	04/25/2000	David L Patton	81003F-P	9422

1333 7590 11/21/2003

PATENT LEGAL STAFF  
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ROCHESTER, NY 14650-2201

EXAMINER
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KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 11/21/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/558,117

Applicant(s)

PATTON ET AL

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2003 has been entered.

The Examiner notes that claims 1-9, 14-15, and 21-24 are indicated as "withdrawn" in the current amendment. However, the claims have been previously cancelled by the amendment filed on May 13, 2003. Therefore, due to the cancellation of the claims, claims 1-9, 14-15, and 21-24 are no longer pending.

### ***Specification***

2. The amendment filed on September 25, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the phrase "the information obtained by scanning of the image is sent to a remote location whereby the information relating to the first and second IDs are compared with information accessed from a known database at the second remote location using the first and second IDs for confirming that the capture device and printing device or location that was used for producing the document at the designated location or

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device”, and the phrase “The image on the document and an image of the presenter is viewed by a camera at the remote location are compared with information obtained from the database to confirm that the individual presenting the document and associated with said first unique ID” on pages 2-3 of the amendment is considered new matter since it is not described by the specification as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Objections*

The following quotations of 37 CFR § 1.75(a) and (d)(1) are the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

3. Claim 10 is objected to under 37 CFR § 1.75 (a) and (d)(1) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

Claim 10 recites the limitation “first and second unique capture IDs” in lines 14-15.

There is insufficient antecedent basis for this limitation in the claim. It appears that the applicant intended the phrase to read “first and second unique IDs”.

Claim 10 recites the limitation “said information” in line 17. There is insufficient antecedent basis for this limitation in the claim. It appears that the applicant intended the phrase to read “wherein information”.

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Claim 10 recites the limitation “said second remote location” in lines 19-20. There is insufficient antecedent basis for this limitation in the claim. It appears that the applicant intended the phrase to read “a second remote location”.

Referring to claim 10, the phrase “for confirming that the capture device and printing device or location that was used for producing said document at said designated location or device” in lines 21-23 is grammatically incorrect. It appears that the applicant intended that phrase to read “for confirming the capture device and printing device or location that was used for producing said document at said designated location or device”.

Claim 10 recites the limitation “said designated location or device” in line 23. There is insufficient antecedent basis for this limitation in the claim. It appears that the applicant intended the phrase to read “said location or device”.

Appropriate corrections are required.

#### ***Claim Rejections - 35 USC § 112***

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claim 10, the phrase “said information obtained by scanning of said image is sent to a remote location whereby said information relating to said first and second IDs are compared with information accessed from a known database at said second remote location for confirming that the capture device and printing device or location that was used for producing

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said document at said designated location or device” in lines 17-23 is not supported by the applicant’s specification. The closest language to this feature appears to be on page 10, line 24 to page 11, line 3 of the applicant’s specification. It appears to indicate that the second ID (50) is compared with information from the database to verify the identity of the person using the document.

Referring to claim 10, the phrase “and the image on the document and an image of the presenter is viewed by a camera at said remote location are compared with information obtained from said database to confirm that the individual presenting the document and associated with said first unique ID” in lines 23-27 is not supported by the applicant’s specification. The closest language to this feature appears to be on page 11, lines 4-15, and page 13, line 26 to page 14, line 9 of the applicant’s specification. It appears to indicate that an image of the presenter is captured by a camera at a remote location, and the captured image along with the unique identification number 50 is transmitted from the remote location to the central location, and compared with the information from the database at the central location.

5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant’s specification is non-enabling in regards to the phrase “said information obtained by scanning of said image is sent to a remote location whereby said information relating to said first and second IDs are compared with information accessed from a known database at said second remote location for

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confirming that the capture device and printing device or location that was used for producing said document at said designated location or device” in lines 17-23. More specifically, it is non-enabling in regards to how information relating to said first ID can confirm the capture device and printing device or location that was used for producing the document, when only the second unique ID (50) provides information in regards to the capture device and printing device or location that was used for producing the document.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 10, the phrase “said information obtained by scanning of said image is sent to a remote location whereby said information relating to said first and second IDs are compared with information accessed from a known database at said second remote location for confirming that the capture device and printing device or location that was used for producing said document at said designated location or device” in lines 17-23 renders the claim indefinite because it is unclear how “information relating to said first ID” can confirm the capture device and printing device or location that was used for producing the document, when only the second unique ID provides information in regards to the capture device and printing device or location that was used for producing the document.

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Referring to claim 10, the phrase “and the image on the document and an image of the presenter is viewed by a camera at said remote location are compared with information obtained from said database to confirm that the individual presenting the document and associated with said first unique ID” in lines 23-27 renders the claim indefinite because it is unclear if both the image on the document and the image of the presenter are viewed by the camera, or if the image on the document, and an image of the presenter viewed by a camera are both compared with information obtained from the database.

Referring to claim 10, the phrase “said remote location” in line 25 renders the claim indefinite because it is unclear whether it is referring to the remote location in line 18, or the second remote location in lines 19-20. It appears that “said remote location” is referring to the remote location in line 18. The Examiner suggests inserting “first” before “remote location” in line 18, and also inserting “first” before “remote location” in line 25.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

*ck*

ck

November 13, 2003

*Jon Chang*  
Jon Chang  
Primary Examiner